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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,683	11/06/2000	Wayne E. Childers JR.	AM100151 01	8281

7590 03/14/2002

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EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 03/14/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/706,683

Applicant(s)
CHILDERS et al.

Examiner
Emily Bernhardt

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 2/19/02 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]


- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 2/19/02. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

4. ☒ Applicant's reply has overcome the following rejection(s):
See attached response.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: _____
Claim(s) objected to: 4, 7-12, 14, and 15
Claim(s) rejected: 1-3, 16, and 26-30
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____


EMILY BERNHARDT
PRIMARY EXAMINER
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The after final response filed 2/19/02 removes nonelected subject matter but does not overcome the 112 and 103 rejections for the following reasons. While the “how to make” aspect of the par. one rejection may be overcome by applicants’ urging that starting materials needed to make instant compounds are commercially available or can be made without undue experimentation, the “how to use” aspect of the rejection has not been addressed. As emphasized in previous actions there are no working examples **representative** of the instant scope drawn to a variety of het rings- both fused and unfused at R1-R3. Thus the amount of guidance presented in the specification as to these (het-substituted) compounds having the necessary 5HT_{1A} agonist or antagonist activity is minimal and consequently applicants’ disclosure provides merely an invitation to those of ordinary skill in the art to determine which compounds have agonist activity for which some compounds tested active in Table 1 and which are antagonistic. The 103 rejection also remains. Applicants appear to be ignoring the compounds pointed out in an earlier action for testing against which for the ethyl species in col.2, lines 22-23 differs in **one respect** from compounds claimed herein. The examiner is not obligated to rely on

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broader disclosures when narrower ones are also present in support of novelty or obviousness. While the amide linking group present in the instant claims and in US'552 are not contained in most of the species of Cliffe, the secondary reference was relied on for showing the one feature of the instant invention not taught by Abou Gharbia, namely the R1 group, which is a preferred embodiment as stated in col.2, line 33 and present in most if not all of the working examples including eg.37. Thus a fair reading of Cliffe when combined with Abou-Gharbia would lead one to modify compounds of the primary reference with aryl on the carbon alpha to the nitrogen atom as was done herein.

Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

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F Bernhardt
EMILY BERNHARDT

PRIMARY EXAMINER

GROUP 1600